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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77199918
Applicant	Chicago Mercantile Exchange Inc.
Applied for Mark	CHI
Correspondence Address	TATYANA V GILLES NORVELL IP LLC 1776 ASH STREET NORTHFIELD, IL 60093 UNITED STATES officeactions@norvellip.com
Submission	Applicant's Request to Extend
Attachments	130924 3d Request For 7 Day Extension of Time CHI final.pdf(14825 bytes )
Filer's Name	Tatyana V. Gilles
Filer's e-mail	tgilles@norvellip.com, officeactions@norvellip.com
Signature	/Tatyana V. Gilles/
Date	09/24/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:	
CHICAGO MERCANTILE EXCHANGE INC.	Examining Attorney:
Serial No.: 77/199,918	Linda A. Powell
Filed: June 7, 2007	Law Office 106
Mark: CHI	

**APPLICANT’S REQUEST FOR A BRIEF SEVEN (7) DAY  
EXTENSION OF TIME TO FILE ITS APPEAL BRIEF**

Applicant, Chicago Mercantile Exchange Inc. (“Applicant”), through its undersigned counsel, files this request in good faith for a brief seven (7) day extension of time to file its appeal brief. The Examining Attorney refused registration of the CHI Mark (“Applicant’s Mark”) arguing that Applicant’s Mark, as used on the specimen of record, merely identifies a process or system and does not function as a service mark to identify and distinguish Applicant’s services from those of others. Applicant appealed the Examining Attorney’s decision. Applicant respectfully requests a mere seven (7) day extension of time to file its appeal brief. As set forth below, Applicant has good cause for filing this brief Request for An Extension of Time and the request should be granted.

**BACKGROUND**

Applicant filed its application to register the mark CHI on June 7, 2007. The Examining Attorney issued her Final Refusal on October 5, 2012. Registration of Applicant’s Mark was refused because, in the Examining Attorney’s opinion, Applicant’s Mark, as used on the specimen of record, merely identifies a process or system and

does not function as a service mark to identify and distinguish Applicant's services from those of others and to indicate the source of those services. 15 U.S.C. §§1051-1053, 1127.

On April 5, 2013, Applicant filed a Request for Reconsideration with the Examining Attorney ("Request for Reconsideration"). Also, on April 5, 2013, Applicant filed its Notice of Appeal and requested that this proceeding be suspended while the Request for Reconsideration was pending. Ultimately, the Request for Reconsideration was denied on May 22, 2013, and the present appeal was resumed. Applicant was given sixty days from the mailing day of the May 27, 2013, Order of United States Patent and Trademark Office Trademark Trial and Appeal Board ("Board"), to file its appeal brief. This deadline was set to expire on July 26, 2013. Applicant filed two requests for an extension of time, both for good cause, which the Board granted. The current deadline for Applicant to submit its appeal brief is September 24, 2013. In the last month, Applicant has made a good faith effort to review the complete record, identify potential areas for remand, and complete its appeal brief; however, Applicant is unable to meet the current filing deadline. As a result, Applicant submits this final extension request and requests a very short extension, i.e., only seven days until October 1, 2013.

## **ARGUMENT**

Under Rule 1203.02(d) of the TTAB Manual of Procedure ("TBMP"), an applicant may request an extension of time to file an appeal brief upon showing good cause for the requested extension. TBMP Rule 1203.02(d). The rule states that "[t]he determination of good cause will be based upon all relevant circumstances, including the length of time of any previously granted extensions." TBMP Rule 1203.02(d). Even

if the Board finds there is no good cause, then Board may still allow the applicant additional time to file its appeal brief or grant the extension and advise that no further extensions will be granted. *Id.*

The present request is Applicant's only third request for an extension of time and Applicant has not previously sought any lengthy extensions of time. In fact, the total extension of time previously granted only amounts to sixty days and Applicant's present request merely seeks a very short period of time of seven days. The present request is made in good faith. After the Request for Reconsideration was denied and this appeal was instituted, Applicant has acted diligently in pursuing this matter. Specifically, Applicant's counsel conducted a thorough review the prosecution history of the application, conducted the necessary legal research, and prepared substantive arguments in support of the appeal. In addition, Applicant's counsel conferred with the Examining Attorney regarding the core issue on appeal, the acceptability of previously submitted specimens, including a review of specimens previously submitted with Applicant's Request for Reconsideration and prosecution of this Application. Applicant's counsel also consulted with Applicant regarding historical and current use of the Applicant's Mark.

The Board has previously recognized that the acceptability of specimens for service marks presents different issues than those raised by goods offered under a mark. See, e.g., *In Re Factory Direct, Inc.*, Ser. No. 77764096, 2013 WL 2951806, at \*1 (T.T.A.B. 2013) (controlling statute and rules create a clear distinction between trademarks and service marks, and case law discusses these respective types of specimens as having different purposes). As a result of this situation, the legal issues in this appeal are complex and focus on both (1) acceptability of specimens for service

marks; and (2) whether or not a mark functions as a service mark. These issues require extensive legal research. Moreover, Applicant must undertake a significant time and expense in order to properly present these issues in its appeal brief. Applicant has no interest in wasting the Board's time, and instead, prefers to present the issues in a clear and straightforward manner for efficient resolution. Applicant requests this additional period of seven (7) days to do so.

Accordingly, Applicant requests this very short third and final extension of time to complete and file its appeal brief. Applicant's request is reasonable, made in good faith, and is not for purposes of delay. Based upon the totality of the circumstances and to conserve the time and resources of all parties involved, Applicant's request for additional time should be granted.

## **CONCLUSION**

Based upon the foregoing, Applicant respectfully requests that the Board grant its final request for a seven (7) day extension of time to file its appeal brief until October 1, 2013. Applicant has demonstrated the requisite good cause to grant this request.

Respectfully submitted,

**CHICAGO MERCANTILE  
EXCHANGE INC.**

Dated: September 24, 2013

By: /Tatyana V. Gilles/  
Joseph T. Kucala, Jr.  
Tatyana V. Gilles  
Norvell IP LLC  
1776 Ash Street  
Northfield, IL 60093  
Tel: 888.315.0732  
Fax: 312.268.5063  
[officeactions@norvellip.com](mailto:officeactions@norvellip.com)

ATTORNEYS FOR APPLICANT